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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005,552	10/29/2001	Jay F. Kunzler	P02460	8018
7590	11/17/2003		EXAMINER	
John E. Thomas Bausch & Lomb Incorporated One Bausch & Lomb Place Rochester, NY 14604			MOORE, MARGARET G	
			ART UNIT	PAPER NUMBER
			1712	

DATE MAILED: 11/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary****Application No.**

10/005,552

**Applicant(s)**

KUNZLER ET AL.

**Examiner**

Margaret G. Moore

**Art Unit**

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 20 to 38 is/are pending in the application.
- 4a) Of the above claim(s) 36 to 38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20 to 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other:

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 20 to 35 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kunzler et al.

This rejection relies on the rationale detailed in the previous office action. Applicants traverse this rejection by stating that the hydrogels in the examples of Kunzler et al. are not the vinyl carbonate endcapped polysiloxanes containing hydrogels claimed. Applicants are reminded, however, that patentees are *not limited to working examples*. As noted in the previous office action, the fluorinated siloxanes in Kunzler et al. have *one of seven* end groups, one of which is a vinyl carbonate endgroup. Thus a siloxane compound meeting the formula in claim 20 is clearly and immediately envisaged from the prior art. Since the claims are anticipated by the prior art, applicants cannot rely on any allegations of improved results in overcoming this rejection.

On the other hand, applicants' reference to the working examples in Tables 1-4 versus those in Tables 2-5 of the instant application are not persuasive of unexpected results since the various results shown in both tables do not appear to rise to the level required to be considered unexpected. Where the prior art reasonably suggests obtaining a particular property, merely testing to determine relative degrees of performance to find a particular species having a higher or lower degree of performance isn't unexpected since obviousness does not require absolute predictability.

A clear and convincing showing of unexpected results must pertain to the full extent of the subject matter claimed. The Examiner notes that it is impermissible to extrapolate from the results obtained with a limited combination of components to expect the same unexpected results for broader combinations of components. In view of the extreme breadth of the claimed composition, open to any amounts of monomers and any type of hydrophilic monomer, not to mention the amount of water in the hydrogel and the optional presence of any additional components, the Examiner simply cannot rely on the results present for any unobviousness.

3. Claims 27 and 29 to 31 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nandu et al.

This rejection relies on reasons of record, noted in the previous office action. Applicants' traversal of this rejection is not persuasive. Applicants state that formula III in Nandu et al. are acrylate terminated. This is not understood. Formula III is specifically defined as a vinyl carbonate or vinyl carbamate and formula on line 38 of column 4 noted in the rejection is clearly vinyl carbonate terminated. Again, the only difference between this polymer and that required by claim 27 is that it does not specifically show fluorinated side chains, but one skilled in the art would have immediately envisioned such groups or would have found such groups obvious in view of the specific alternative choice provided by applicants.

4. This application contains claims 36 to 38 drawn to an invention nonelected with traverse in the paper dated 1/29/03. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 703-

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308-4334. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

A handwritten signature in black ink, appearing to read "Margaret G. Moore". The signature is fluid and cursive, with the first name "Margaret" being more prominent than the last name "Moore".

Margaret G. Moore

Primary Examiner

Art Unit 1712

mgm

11/12/03